

Amendment and Response

Page 11 of 13

Serial No.: 10/028,616

Confirmation No.: 6755

Filed: December 21, 2001

For: METHODS FOR PLANARIZATION OF GROUP VIII METAL-CONTAINING SURFACES USING A
FIXED ABRASIVE ARTICLE**Remarks**

The Office Action mailed July 27, 2004 has been received and reviewed. Claims 1, 10, 14, 24, 25, 26, 27, 39, 40, 41, and 42 having been amended, the pending claims are claims 1-33 and 35-42. Reconsideration and withdrawal of the rejections are respectfully requested.

The 35 U.S.C. §112, Second Paragraph, Rejection

The Examiner rejected claims 39-42 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner objected to language in claim 39 ("the rate of removal of material is greater than the rate of removal of material from a generally planar surface of the same materials under the same conditions.") and the language in claim 42 ("the method results in reduces smearing and defect formation of the surface compared to the same method and surface planarized with a fixed abrasive article comprising alumina or silica particles."). These rejections are respectfully traversed.

Claim 39 has been amended to clarify that the material being referred to is Group VIII metal-containing material. Accordingly, the rejection of claim 39 is rendered moot.

Claim 42 has been amended to clarify that the fixed abrasive includes CeO_2 , Y_2O_3 , Fe_2O_3 , or mixtures thereof. Accordingly, the rejection of claim 42 is rendered moot. However, Applicant's Representatives do not agree with the Examiner's opinion. Prior to amendment, the claim language used defined the abrasive particles in the fixed abrasive by hardness level. It is respectfully submitted that this language is sufficient to define a class of materials. That is, the language used in all claims defining the abrasive particles as having a hardness of greater than about 6.5 Mohs is sufficiently definite to identify the particles used in the fixed abrasive.

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Page 12 of 13

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FIXED ABRASIVE ARTICLE**The 35 U.S.C. §103 Rejection**

The Examiner rejected claims 1-33 and 35-38 under 35 U.S.C. §103 as being unpatentable over Russel et al. as modified by James et al. and further in view of Sachan et al. (WO 01/44396).

This rejection is respectfully traversed. It is respectfully submitted that the Examiner has used hindsight reconstruction by combining three documents in making the rejection. However, in the interest of expediting prosecution, each independent claim was amended to incorporate language of claim 42 ("wherein the method results in reduced smearing and defect formation on the planarized surface compared to the same method and surface planarized with a fixed abrasive article comprising alumina or silica particles"), which was not rejected under 35 U.S.C. § 103. However, Applicant's Representatives do not agree with the Examiner's opinion and reserve the right to present the claims prior to amendment and arguments in a continuing application. Thus, the amendments made herein are solely for the purpose of expediting prosecution.

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It is respectfully submitted that the pending claims 1-33 and 35-42 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
Sabde

By

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October 26, 2004
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26th day of October, 2004, at 2:18 pm (Central Time).

By: Sara E. OlsonName: SARA E. OLSON